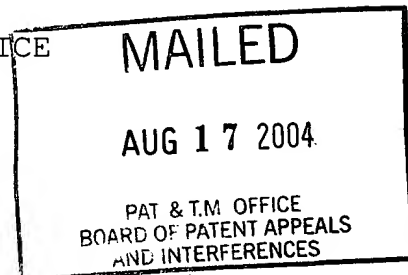


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte BRUCE L. ADAMS and IRWIN PEARL

Appeal No. 2004-0144
Application No. 09/294,461

ON BRIEF

Before GARRIS, FLEMING, and OWENS, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

REMAND TO EXAMINER

The above identified application is hereby remanded to the jurisdiction of the Examining Corps so that the examiner can take appropriate action consistent with our comments below.

The final Office action mailed July 1, 2002 included various prior art rejections based on various reference combinations of all pending claims 1-8, 11-13 and 25-40. Subsequent to this

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final Office action, the appellants canceled claims 1-8, 11-13 and 25-28 (via the amendment filed November 8, 2002), thereby leaving only claims 29-40 pending in this application. In response to the appellants' Notice of Appeal and Appeal Brief concerning these pending claims 29-40, the examiner included in his Answer the various final rejections of now canceled claims 1-8, 11-13 and 25-28. On page 3 of the Answer, the examiner offered the following explanation of his reasons for this inclusion:

Claims 1-8, 11-13 and 25-27 [sic, 25-28] have been cancelled by Appellants in Paper #15, but were examined in the FINAL REJECTION, and are repeated below from Paper #13 for clarity and completeness since some of the remaining claims were rejected with reference to claims that have now been cancelled by Appellants [sic].

More specifically, the Answer presents section 103 rejections of: canceled claims 1, 2, 4-8, 12 and 13 over Zip Coupons in view of Excite and Scroggie; canceled claim 3 over Zip Coupons in view of Excite, Scroggie and Katz; canceled claims 25-28 over Zip Coupons in view of Scroggie and Burke; canceled claim 11 as well as appealed claims 29, 30 and 32-40 over Zip Coupons in view of Excite, Scroggie and Burke; and appealed claim 31 over Zip Coupons in view of Excite, Scroggie, Burke and Katz. As indicated by the examiner in the above quotation, appealed claims

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29-40 have been rejected "with reference to claims that have now been cancelled" (answer, page 3). For example, in presenting his rejection of canceled claim 11 as well as appealed claims 29, 30 and 32-40 over Zip Coupons in view of Excite, Scroggie and Burke, the examiner's only discussion of appealed independent claim 29 is that "[c]laim 29 is written as a system and contains essentially the same limitations as the combination of [now canceled] claims 1 and 11; therefore the same rejection is applied" (answer, page 14; emphasis added).

On its face, the examiner's characterization of claim 29 as containing "essentially the same limitations as the combination of claims 1 and 11" (id.) raises the question of whether the appealed claim contains other limitations not present in the canceled claims. Moreover, it was inappropriate for the examiner to have stated that "the same rejection is applied" (id.) against appealed claim 29 as was applied against canceled claims 1 and 11. This is because claims 1 and 11 were separately rejected over different combinations of references. Similarly, the examiner inappropriately stated that claim 30 "contains essentially the same limitations as claim 2; therefore, the same rejection is applied" (answer, page 14). Again, this is because the statement of rejection concerning appealed claim 30 involves

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different references (i.e., Zip Coupons, Excite, Scroggie and Burke) than the statement of rejection concerning canceled claim 2 (i.e., Zip Coupons, Excite and Scroggie). Analogous concerns are raised by the examiner's treatment of the other appealed claims including separately rejected appealed claim 31.

The circumstances recounted above are all occasioned by the examiner's failure to follow the rejection guidelines set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j) and §§ 2141-2144.09 (8th ed., Rev. 2, May 2004). As a result of this failure, the rejections advanced by the examiner on this appeal lack clarity vis-à-vis the appealed claim differences over the applied references, the proposed modification of the applied references necessary to arrive at the subject matter defined by the appealed claims and correspondingly an explanation as to why one of ordinary skill in the art would have been motivated to make the proposed modification. Due to this lack of clarity, an informed decision cannot be rendered in the subject appeal.

Therefore, upon receipt of this application, the examiner must reevaluate his section 103 analysis of appealed claims 29-40 in accordance with the aforementioned MPEP guidelines. If this reevaluation leads to a determination that his section 103 rejections of these appealed claims should be maintained, the

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examiner must reformulate these rejections so as to be in compliance with the previously noted guidelines. Furthermore, in order to avoid concerns of the type discussed above, any such reformulated rejections must not be constructed with reference to now canceled claims or prior rejections thereof. Pursuant to 37 CFR § 1.193(b)(1)(2003), we hereby authorize the examiner to present any such reformulated rejections of the appealed claims by way of a Supplemental Examiner's Answer. See MPEP § 1211 (August 2001). Should a Supplemental Examiner's Answer be issued, the appellants will have the right to file a Supplemental Reply Brief in response thereto.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D) (8th ed. Rev. 2, May 2004). It is important that the Board be promptly informed of any action affecting the appeal in this case.

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